

REMARKS

Claims 1-63 are remaining in this application, with Claims 1-53 amended above, and new Claims 54-63 added. The Application respectfully requests reconsideration and review of the application in view of the following remarks.

The Examiner objected to the incorporation by reference of U.S. Provisional Application No. 60/067,123 and PCT/US98/25541. The Applicant claims priority to these applications pursuant to 35 U.S.C. §§ 120 and 119(e), respectively. The incorporation by reference of these applications is thus unnecessary, and has been canceled from the present application.

Before addressing the merits of the rejections based on prior art, the Applicant provides the following brief description of the application. The application is directed to a transaction terminal, such as an automated transaction machine (ATM), that provides significantly greater flexibility and convenience than conventional ATMs, and is referred to in the application as a Super-ATM. A limitation of conventional ATMs is that they communicate only using the standard industry protocol/message set defined by ISO 8583, and as a result conventional ATMs can only perform certain types of financial transactions (e.g., withdrawing cash, checking account balance, etc.) The transaction terminal of the present application communicates using plural types of protocols/message sets, and can therefore communicate with other types of computer networks besides the ATM network, such as the point-of-sale (POS) protocol used to communicate credit card transactions with commercial banking networks and the TCP/IP protocol used on the Internet. Thus, the transaction terminal can enable many different kinds of transactions than conventional ATMs, including purchasing goods/services, checking e-mail messages and paying bills. Moreover, the transaction terminal can accept payment using many different options, including currency, credit/debit cards or check.

The claims are amended solely to place them in better form for allowance. The amendments are not considered necessary to distinguish the prior art references cited by the Examiner. New Claims 54-63 are directed to additional aspects of the present

invention.

The Examiner has rejected Claims 1-53 under 35 U.S.C. § 103(a) as unpatentable over Gill et al. This rejection is respectfully traversed.

Gill discloses a fault monitoring and notification system for automated banking machines, i.e., ATMs. In addition to the standard format messages generated by ATMs, individual manufacturers of ATMs include proprietary device status messages used to indicate a condition of the ATM, such as an out of money condition. These device status messages are used to notify the ATM network of the condition with a particular ATM so that a service call can be initiated, such as to replenish the money in the particular ATM. According to the reference, the device status messages may be "solicited" (i.e., in response to a query from the host) or "unsolicited" (i.e., generated by the ATM in response to an alarm condition). The ATM network described in Gill includes a plurality of different types of ATMs that may be each provided by separate manufacturers. In order to decipher the proprietary device status messages generated by each of the ATMs, Gill discloses an event management system 20 that converts the status messages into a common message format. The common message format is then used to take action on the particular status messages, such as to initiate a service call to perform maintenance on the ATM.

There is a fundamental distinction between the Gill fault monitoring and notification system and the present invention. While Gill is directed to permitting a plurality of disparate ATMs to communicate with a central network, the present application is directed to a single ATM that can communicate with plural different networks. Notably, the ATMs operating in the Gill network can only communicate with an ATM network and to the service organization of their corresponding manufacturer. The Gill ATMs cannot communicate with any other type of network besides the ATM network. Even though Gill discloses plural agents that provide "service" to the ATMs, it should be appreciated that any one ATM of the network will only communicate with one corresponding service agent. Gill therefore fails to suggest or disclose a single ATM that can communicate with plural networks as in the present application.

It should also be appreciated that the "service agents" described by Gill are fundamentally different than the "service providers" described in the present application and defined in certain claims. The Gill service agents provide service to the ATMs, i.e., maintenance service, but do not provide a service for the users of the ATMs. A user of the Gill device would never need or desire to conduct a transaction with a service agent. In contrast, the service providers described in the present application provide distinct types of service to the users of ATMs and other transaction terminals, such as bill payment, ticket purchasing, etc.

Moreover, the communications between the ATMs and the Gill event management system 20 are one-way in nature, since the event management system does not communicate messages back to the ATMs. The device status messages are not initiated in response to an input by a user, but are initiated either in response to a solicitation by the host or by the ATM autonomously due to a fault condition. In this regard, the Gill communications do not constitute "transactions" as this term is used in the present application. A "transaction" generally requires a two-way exchange of information. A transaction generally includes three components: first, a communication of a request; second, a processing of the request; and third, a communication of a reply to the request. For example, when a user of the transaction terminal of the present application submits a request to purchase movie tickets, there is a communication of the request from the ATM to the host network and then to the movie ticket network, processing of the request by the movie ticket network to purchase the tickets, and communication of a reply message back to the ATM through the host confirming the purchase. Gill is simply not suited to allow an ATM to conduct transactions with other networks besides the host computer which require two-way communication that is responsive to user input.

Particularly, with respect to Claim 1, Gill fails to suggest or disclose "a transaction terminal adapted to communicate with the first service provider with the first formatted message in response to a first user input, and with the second service provider with the second formatted message in response to a second user input." Similarly, with respect

to Claim 17, Gill fails to suggest or disclose "a transaction terminal adapted to communicate with both the first service provider with the first formatted message and the second service provider with the second formatted message in response to a first user input." As discussed above, Gill does not permit a transaction terminal to communicate with both a "first service provider" and a "second service provider," and any communication that does occur between an ATM and the Gill event management system is not in response to a user input. The rejection of these claims and all claims dependent thereto should therefore be withdrawn.

With respect to Claims 36 and 48, Gill fails to suggest or disclose a "method for performing a transaction with one of a plurality of service providers from a single transaction terminal." As noted above, Gill discloses an ATM that can perform a "transaction" with only a single service provider, i.e., the ATM host. The one-way processing of device status messages from the ATMs do not comprise "transactions." In this regard, Gill further fails to suggest or disclose "selecting, at the transaction terminal, one of the service providers in response to the request," as defined in Claims 36 and 48. The user of the Gill ATM cannot make any such selection among service providers. The rejection of these claims should also be withdrawn.

The Examiner acknowledges that Gill fails to disclose a card dispenser as defined in Claims 8, 25 and 34, but states that "ATM machines writing information to IC cards is old and well known." The Applicant respectfully disagrees. The Examiner cites no evidence for such teaching, and apparently relies solely on apparent personal knowledge of the art. If the Examiner persists with this ground of rejection, the Applicant respectfully requests that the Examiner cite specific references showing such teaching. Even assuming that the "writing" of information to a card by an ATM were known in the art, this is not the same as "dispensing" a card. The transaction terminal of the present application has the capability of dispensing a card to a user, such as a pre-paid phone card. Gill fails to suggest or disclose such a capability.

It is further noted that Gill fails to disclose either of: "a sensor for extracting identification information;" "a product multimedia dispenser for dispensing a multimedia

product;" or "a multimedia printer for generating a printed media" as defined in Claim 34 and other claims. In view of the fact that conventional ATMs are restricted to performing certain types of financial transactions due to the aforementioned limitations of their message protocol, there would be no reason to include the "sensor," "product multimedia dispenser" and/or "multimedia printer" in a conventional ATM as disclosed by Gill. Therefore, the rejection of these claims should also be withdrawn.

The Examiner further acknowledges that Gill fails to disclose the MICR reader, biometric sensor, signature pad or OCR reader, as defined in Claims 12-16, 29-33 and 35. As noted above, there would be no reason to include any of these systems with a conventional ATM, such as in Gill, in view of the limitations of such ATM systems. As requested above, the Examiner should cite specific references showing such teachings if this ground of rejection is maintained in any subsequent action. Otherwise, the rejection of these claims should also be withdrawn.

The dependent claims define additional aspects of the invention that are not suggested or disclosed by Gill. For example, Claims 2 and 18 further define the first service provider as being a "banking network" and the second service provider as being a "non-banking network." Gill fails to suggest or disclose an ATM that can communicate or conduct transactions with a non-banking network.

In view of the foregoing, the Applicant respectfully submits that Claims 1-63 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited.

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Our check in the amount of \$336.00 is enclosed for the addition of two (2) independent claims in excess of three (3) pursuant to 37 C.F.R. § 1.16(b), and the addition of ten (10) total claims in excess of twenty (20) pursuant to 37 C.F.R. § 1.16(c). The Commissioner is authorized to charge any shortage in the fees, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "BBL", written over a horizontal line.

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Date: March 27, 2000

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